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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,337	08/08/2001	Shell S. Simpson	10007652-1	1943

7590 03/31/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

MAIL DATE	DELIVERY MODE
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03/31/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON and WARD S. FOSTER

Appeal 2007-3616
Application 09/923,337
Technology Center 2100

Decided:

Before ALLEN R. MACDONALD, JEAN R. HOMERE, and CAROLYN
D. THOMAS, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from a final
rejection of claims 1-23.

Claim 1 is exemplary:

1. A method for providing imaging conversion services on content, comprising the steps of:

receiving content comprising non-image data;

obtaining a style sheet defining a conversion of the received content to a converted content;

determining a desired format for a desired destination for the content;

selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format;¹

converting the content using the selected imaging conversion program and the style sheet to obtain the converted content; and

transmitting the converted content to the desired destination.

The references relied upon by the Examiner in rejecting the claims on appeal are:

Todaka	US 6,785,022 B1	Aug. 31, 2004 (filed Apr. 1, 1999)
Li	US 2004/0205613 A1	Oct. 14, 2004 (filed Jul. 17, 2001)

Houser, *Using Style Sheets to Publish XML to the Web*, 1-10, 2000.

¹ We refer to this step as the “selecting step.”

Claims 1-23 stand rejected under 35 U.S.C. § 112, first paragraph for failing to satisfy the enablement requirement.

Claims 1-4, 6-12, and 17-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Li.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Li and Todaka.

Claims 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Li and Houser.

We affirm.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Li

1. Li discloses using a template to transform a document. (¶[0057].)
2. Li discloses transforming a document using a template in a manner defined by a style sheet. (¶[0065].)
3. Li discloses that the template transforms documents from a first document language, such as XML, to another document language, such as HTML. (*Id.*)

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

§ 112, first paragraph

The Examiner concludes that the Specification fails to enable the selecting step, which is found in all claims, because (1) Appellants' Specification describes selecting a program based on style sheet *alone* and thus the invention can be practiced without determining the desired format, which leads to an impossibility in achieving selecting a program based on *both* style sheet and *desired format* and (2) Appellants' Specification describes selecting a program based on the style sheet *and/or* the format and thus it is *unclear* to one of ordinary skill in the art whether consideration of

style sheet, format, or style sheet *and* format is actually implemented. (Ans. 4-5 and 13-17.)

Appellants respond:

Paragraphs [0182]-[0184] of the Specification discuss and enable the steps of obtaining a style sheet and determining a format. While paragraph [0184] does mention that the step of determining a format is optional, paragraph [0185] discusses that an imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet and/or the desired format.

(Reply Br. 3.)

The use of the logical expression “and/or” [in paragraph [0185]] clearly indicates that the imaging conversion program can be selected based on: (a) the style sheet, (b) the desired format information, or (c) both the style sheet and the desired format information.

(App. Br. 5.)

We agree with Appellants. We find that use of the term “and/or” is a succinct manner of describing all of Appellants’ scenarios (a)-(c). Moreover, the use of the term “optional” in reference to selecting a program based on a desired format saves the Appellants from describing an embodiment with the optional aspect and another embodiment without the optional aspect. We find that Appellants’ originally filed Specification describes a manner of selecting an imaging conversion program based on the style sheet and the desired format. (Spec. ¶¶[0182]-[0185].) Thus, we conclude that the originally filed Specification describes the claimed selecting step so that an artisan could make or use the claimed selecting step

without undue experimentation. Therefore, we conclude that Appellants have shown that the Examiner erred in concluding that claims 1-23 fail to satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph.

§ 102

Claim 1

The Examiner finds that Li anticipates claim 1. (Ans. 6.) Appellants allege that Li fails to disclose the selecting step of claim 1 because Li fails to disclose selecting based on two factors comprising *a style sheet and desired format*. (App. Br. 6 and Reply Br. 4.) We note that Appellants do not dispute the Examiner's findings that Li's template discloses an imaging conversion program (Ans. 6). (App. Br. 6 and Reply Br. 4.) Thus, the issue is whether Appellants have shown that the Examiner erred by finding that Li discloses selecting a template based on the two factors.

We begin our analysis by construing the claimed "desired format" of the two factors. Appellants' Specification describes a format as a document language such as a PDF file or PCL 6. (Spec. ¶[0184].) Accordingly, we broadly but reasonably construe the claimed desired format as a document language.

Li discloses using a template to transform a document using a style sheet. (FF 1 and 2.) Li discloses that the template transforms documents from a first document language, such as XML, to another document language such as HTML. (FF 3.) Accordingly, we find that Li discloses selecting templates based on a style sheet and the desired resulting document

language. Li's desired resulting document language discloses the claimed desired format. Thus, we find that Li discloses selecting a template based on a style sheet and a desired format. Accordingly, we conclude that Appellants have not shown that the Examiner erred in finding that Li discloses selecting a template based on the two factors. Therefore, we conclude that Appellants have not shown that the Examiner erred in finding that Li anticipates claim 1.

Claims 2-23

Claims 2-4, 6-12, and 17-23 are subject to the same rejection as that of claim 1. Accordingly, we conclude that Appellants have not shown that the Examiner erred in finding that Li anticipates these claims for the same reasons set forth with regard to claim 1.

Claim 5 and claims 13-16 are subject to obviousness rejections based on the same reference as that used to reject claim 1 as well as another reference. For all of these claims, Appellants rely on the same reasons applied to claim 1 to allege Examiner error. (App. Br. 7 and Reply Br. 5-6.)

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Accordingly, Appellants have not persuaded us that the Examiner erred in concluding that these claims are obvious over the cited references.

Furthermore, for reasons provided *supra* with regard to claim 1, we conclude that Appellants have not shown that the Examiner erred in

concluding that (i) Claim 5 is obvious over Li and Todaka and (ii) Claims 13-16 are obvious over Li and Houser.

CONCLUSION OF LAW

We conclude that:

(1) On the record, Appellants have shown that the Examiner erred in concluding that Claims 1-23 are unpatentable under 35 U.S.C. § 112, first paragraph for failing to satisfy the enablement requirement;

(2) Appellants have not shown that the Examiner erred in finding Claims 1-4, 6-12, and 17-23 anticipated by Li under 35 U.S.C. § 102(e);

(3) Appellants have not shown that the Examiner erred in concluding that Claim 5 is unpatentable under 35 U.S.C. § 103(a) over Li and Todaka;

(4) Appellants have not shown that the Examiner erred in concluding that Claims 13-16 are unpatentable under 35 U.S.C. § 103(a) over Li and Houser; and

(5) Claims 1-23 are unpatentable.

DECISION

The Examiner's rejections of claims 1-23 under 35 U.S.C. § 112, first paragraph are reversed.

The Examiner's rejections of claims 1-4, 6-12, and 17-23 under 35 U.S.C. § 102(e) are affirmed.

The Examiner's rejections of claims 5 and 13-16 under 35 U.S.C. § 103(a) are affirmed.

Appeal 2007-3616
Application 09/923,337

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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